Docket No. 210374US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:	
Laurence SEBILLOTTE-ARNAUD, et al.	:	EXAMINER: N. Ogden, Jr.
SERIAL NO: 09/903,785	:	
FILED: July 13, 2001	:	GROUP ART UNIT: 1751

FOR: CLEANSING COSMETIC COMPOSITION

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

Appellants submit this brief in response to the Rejection dated October 2, 2007 and the Notice of Non-Compliant Appeal Brief dated May 9, 2008.

REAL PARTY IN INTEREST

The real party in interest herein is L'Oréal S.A. of Paris, France.

RELATED APPEALS AND INTERFERENCES

To the best of Appellants' knowledge, there are no appeals or interferences which will directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

STATUS OF CLAIMS

Claims 1-9, 11-21 and 23 are rejected and on appeal. Claims 10 and 22 have been canceled.

STATUS OF AMENDMENTS

All amendments and remarks filed in this case have been entered and considered.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1: The Invention relates to a cleansing composition (Specification at page 3, line 4), comprising:

(1) at least one foaming surfactant (Specification at page 3, line 6),

(2) at least 1 % by weight of at least one hydrophilic silica, relative to the total weight of the composition (Specification at page 3, lines 6-7),

(3) at least one oxyalkylenated compound which is a thickening agent present in a thickening effective amount (Specification at page 26, lines 1-11),

and is selected from the group consisting of: (a) polyethylene glycols having a number of ethylene oxide units greater than or equal to 800; (b) polyethylene and/or polypropylene glycol esters having the formula:

$$RCOO\text{-}(EO)_m\text{-}(PO)_n\text{-}R'$$

wherein $0 < m \leq 300$ and $0 \leq n \leq 300$ and $m + n \geq 6$, R and R' represent, independently of each other, hydrogen or a saturated or unsaturated, linear or

branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the proviso that R and R' are not simultaneously hydrogen; (c) polyethylene glycol ethers having the formula

$$R\text{-}(EO)_m\text{---}(PO)_n\text{-}R'$$

wherein $0 < m \leq 300$ and $0 \leq n \leq 300$ and $m + n \geq 6$, R and R' represent, independently of each other, hydrogen or a saturated or unsaturated, linear or branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the provisos that (i) R and R' are not simultaneously hydrogen, and (ii) where either R or R' is hydrogen, the other comprises an alkyl chain comprising 12 to 22 carbon atoms, an aryl group, or mixtures thereof; (d) alkoxylated polyol fatty acid esters; (e) alkoxylated polyol fatty alcohol ethers; (f) alkoxylated glyceryl triesters of fatty acids; (g) ethoxyethylenated urethane derivatives modified with alkyl chains; and (h) mixtures thereof (Specification at page 10, line 8 through page 15, line 9), and

(4) a physiologically acceptable aqueous medium comprising at least 35 % by weight of water, relative to the total weight of the composition (Specification at page 3, line 5).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-23 are obvious under 35 U.S.C. § 103 over Glenn (U.S. patent 6,277,797 or WO 96/28140).
2. Whether claim 1 fails to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph.

ARGUMENT

I. Claims 1-23 are not obvious under 35 U.S.C. § 103 over Glenn

The invention compositions require the presence of **a thickening effective amount** of at least one oxyalkylenated compound **thickening agent**. Glenn does not teach or suggest such compositions.

First, Glenn does not disclose or suggest adding the required oxyalkylenated **thickening agent** to his compositions. Instead, Glenn discloses, at col. 3, lines 5-27, polyols having at most 200 alkoxylated groups (n = 200). Glenn's polyols are used as "humectants and solutes." (See, col. 3, line 1). Nowhere does Glenn teach or suggest using his polyols to thicken his compositions.

In this regard, Appellants note that the CTFA handbook evidence of record indicates that PEG compounds having 200 ethoxylation units or less are "solvents," not thickening agents.[1] Thus, Glenn's disclosure of PEG compounds up to PEG-200 (n = 200) cannot teach or suggest the claimed thickening agents. Rather, the disclosure relates to solvents for Glenn's compositions which are expressly liquid compositions.

One skilled in the art, following Glenn, would not have been motivated to add a PEG compound which is a thickening agent in a viscosity increasing amount to yield the claimed compositions.

The significance of the requirement that the required oxyalkylenated compounds be thickening agents is demonstrated by the examples in the present specification. Comparative example 2 (pages 24-25) does not contain PEG-120 methylgluclose dioleate, an

[1] For sake of completeness, Appellants submit herewith pages 969-976 of the CTFA handbook (2000).

oxyalkylenated thickening agent, but it does contain two of Glenn's acceptable solutes/humectants, sorbitol and glycerol. (See, Glenn at col. 13, lines 14-15). This comparative composition is a "translucent liquid product like water." Thus, compositions containing only Glenn's solutes/humectants result in unacceptable products. However, when thickening agent PEG-120 methylgluclose dioleate is added, the resulting composition is a "thick translucent gel." (Example 1, pages 24-25). Thus, adding the claimed oxyalkylenated compound in a composition thickening effective amount results in a product having superior, more desirable properties, whereas adding Glenn's solutes/humectants does not.

For at least this reason Glenn neither teaches nor suggests the invention compositions.

Second, Glenn does not disclose the presence of **a thickening effective amount** of the required thickening agent. For Glenn to disclose a thickening effective amount of the required oxyalkylenated thickening agent, it would have to disclose or suggest actually thickening compositions with an oxyalkylenated compound. *See, Abbott Laboratories v. Baxter Pharmaceutical Products, Inc.,* 67 U.S.P.Q.2d 1191 (Fed. Cir. 2003)("effective amounts" are not necessarily disclosed by prior art compositions containing the claimed active ingredient; the desired effect must be achieved). Merely because Glenn suggests that oxyalkylenated compounds can be added as humectants, solutes and surfactants does not mean that it discloses or suggests thickening compositions with such compounds. *See, Abbott Laboratories.*

Based on Glenn's disclosure related to the limited purposes for which oxyalkylenated compounds could be added to his compositions, no motivation would exist for one skilled in the art to actually thicken Glenn's compositions using a thickening effective amount of an

oxyalkylenated compound. Rather, one skilled in the art would add oxyalkylenated compounds in humectant, solute and/or surfactant effective amounts. Thus, Glenn neither teaches nor suggests the required element that the oxyalkylenated compound be present in a thickening effective amount.

For this reason as well Glenn neither teaches nor suggests the invention compositions.

Third, the invention compositions require the presence of (1) at least one foaming surfactant, (2) at least 1 % by weight of at least one hydrophilic silica, **and** (3) at least one oxyalkylenated compound, wherein the oxyalkylenated compound is a thickening agent present in a composition thickening effective amount. As demonstrated in comparative examples 1-3 set forth on pages 24 and 25 of the present specification, if one of these required ingredients is missing, the resulting composition is unacceptable. In stark contrast, invention example 1 set forth on pages 24 and 25 demonstrates that compositions containing all three of the required ingredients possess superior, more desirable properties. These examples demonstrate the criticality of having all three of the required ingredients present in the same composition.

For such compositions to be obvious under 35 U.S.C. §103, Glenn must motivate or suggest to one skilled in the art to combine all three required ingredients into a single composition. Glenn, however, does not provide the necessary suggestion or motivation. In particular, Glenn does not teach or suggest adding **a thickening effective amount** of at least one oxyalkylenated compound **thickening agent** to his compositions.

For this reason as well Glenn neither teaches nor suggests the invention compositions.

Fourth, the Glenn does not teach or suggest the specific thickening agents identified in claim 23 (which excludes PEG compounds). For this reason as well Glenn neither teaches nor suggests the invention composition of claim 23.

For all of the above reasons, Glenn cannot teach or suggest the invention compositions, and no case of *prima facie* obviousness has been set forth.

II. Claim 1 satisfies the written description requirement of 35 U.S.C. § 112

The Examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph, asserting that the limitation in subpart (a) requiring the polyethylene glycol to have a number of ethylene oxide units greater than or equal to 800 does not satisfy the written description requirement. This rejection is erroneous.

To satisfy the written description requirement, Appellants must convey with reasonable clarity to those skilled in the art that they were in possession of the claimed invention as of the filing date of the application. *See, Vas-Cath, Inc. v. Mahurkar,* 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. *See, In re Marzocchi,* 439 F.2d 220, 224 (CCPA 1971). Thus, the Examiner has the burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *See, In re Wertheim,* 541 F.2d 257, 262-63 (CCPA 1976).

Here, the Examiner has not met his burden. The present application, filed July 13 2001, discloses using thickening effective amounts of PEG thickening agents. The 2000

version of the CTFA handbook discloses that PEG-800 is a thickening agent. Based on this evidence, one skilled in the art in 2001 would understand that the present application, which discloses using PEG thickening agents, encompasses PEG-800 (a known thickening agent in 2001). No evidence to the contrary exists -- that is, no evidence exists that one skilled in the art would not recognize that PEG-800 is encompassed within the disclosure of the present application.

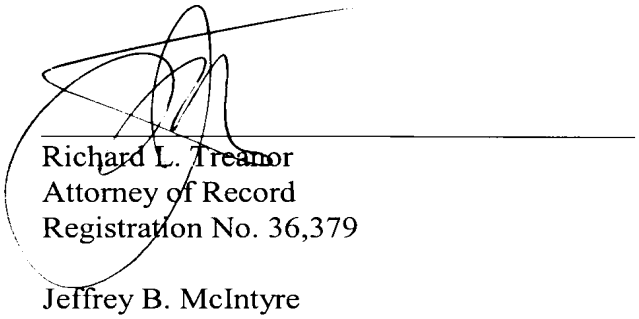
Accordingly, the present application satisfies the written description requirement.

III. **Conclusion**

In view of the above remarks and reasons explaining the patentable distinctness of the presently appealed claims over the applied prior art, Appellants request that the Examiner's rejections all be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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APPENDIX I (CLAIMS)

Claim 1. (Previously Presented): A cleansing composition, comprising:

(1) at least one foaming surfactant, (2) at least 1 % by weight of at least one hydrophilic silica, relative to the total weight of the composition, and (3) at least one oxyalkylenated compound which is selected from the group consisting of oxyethylenated compounds and oxyethylenated/oxypropylenated compounds in a physiologically acceptable aqueous medium comprising at least 35 % by weight of water, relative to the total weight of the composition, wherein said oxyalkylenated compound is a thickening agent present in a composition thickening effective amount and is selected from the group consisting of

(a) polyethylene glycols having a number of ethylene oxide units greater than or equal to 800;

(b) polyethylene and/or polypropylene glycol esters having the formula:

$$RCOO\text{-}(EO)_m\text{-}(PO)_n\text{-}R'$$

wherein $0 < m \leq 300$ and $0 \leq n \leq 300$ and $m + n \geq 6$, R and R' represent, independently of each other, hydrogen or a saturated or unsaturated, linear or branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the proviso that R and R' are not simultaneously hydrogen;

(c) polyethylene glycol ethers having the formula

$$R\text{-}(EO)_m \text{---} (PO)_n\text{-}R'$$

wherein $0 < m \leq 300$ and $0 \leq n \leq 300$ and $m + n \geq 6$, R and R' represent,

independently of each other, hydrogen or a saturated or unsaturated, linear or branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the provisos that (i) R and R' are not simultaneously hydrogen, and (ii) where either R or R' is hydrogen, the other comprises an alkyl chain comprising 12 to 22 carbon atoms, an aryl group, or mixtures thereof;

(d) alkoxylated polyol fatty acid esters;

(e) alkoxylated polyol fatty alcohol ethers;

(f) alkoxylated glyceryl triesters of fatty acids;

(g) ethoxyethylenated urethane derivatives modified with alkyl chains; and

(h) mixtures thereof.

Claim 2: (Original): The composition according to Claim 1, which has a complex modulus G* ranging from 102 to 105 Pa and a loss angle ranging from 2°C to 45° C for frequencies ranging from 0.01 to 10 Hz.

Claim 3: (Original): The composition according to Claim 1, which comprises from 35 % to 95 % by weight of water relative to the total weight of the composition.

Claim 4: (Original): The composition according to Claim 1, wherein the amount of hydrophilic silica(s) ranges from 1% to 15% on an active material weight basis relative to the total weight of the composition.

Claim 5: (Original): The composition according to Claim 1, wherein the hydrophilic silica is selected from the group consisting of silicas of pyrogenic origin, of precipitated origin, and mixtures thereof.

Claim 6: (Original): The composition according to Claim 1, wherein the hydrophilic

silica is selected from the group consisting of silicas having a specific surface ranging from 30 to 500 m^2/g, a number-average particle size ranging from 3 to 50 nm and a compacted density ranging from 40 to 200 g/l.

Claim 7: (Original): The composition according to Claim 1, wherein the hydrophilic silica is a pyrogenic silica.

Claim 8: (Original): The composition according to Claim 7, wherein the hydrophilic silica consists of a particle coated with hydrophilic silica.

Claim 9: (Original): The composition according to Claim 1, wherein the amount of oxyalkylenated compound(s) ranges from 1 % to 20 % on an active material weight basis relative to the total weight of the composition.

Claim 11 (Previously Presented): A composition according to Claim 1, wherein at least one of the oxyalkylenated compound(s) have the formula:

$$RCOO\text{-}(EO)_m\text{-}(PO)_n\text{-}R'$$

wherein $0 < m \leq 300$ and $0 \leq n \leq 300$ and $m + n \geq 6$, R and R' represent, independently of each other, hydrogen or a saturated or unsaturated, linear or branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the proviso that R and R' are not simultaneously hydrogen.

Claim 12 (Previously Presented): A composition according to Claim 1, wherein at least one of the oxyalkylenated compound(s) have the formula:

$$R\text{-}(EO)_m\text{---}(PO)_n\text{-}R'$$

wherein $0 < m \leq 300$ and $0 \leq n \leq 300$ and $m + n \geq 6$, R and R' represent, independently of each other, hydrogen or a saturated or unsaturated, linear or branched, hydroxylated or non-

hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the proviso that R and R' are not simultaneously hydrogen.

Claim 13: (Original): The composition according to Claim 1, wherein the foaming surfactant is selected from the group consisting of nonionic surfactants, anionic surfactants, amphoteric surfactants and zwitterionic surfactants, and mixtures thereof.

Claim 14: (Original): The composition according to Claim 1, wherein the amount of foaming surfactant(s) ranges from 2 % to 50 % on an active material weight basis relative to the total weight of the composition.

Claim 15: (Original): The composition according to Claim 11, wherein the foaming surfactant is selected from the group consisting of alkyl polyglucosides, maltose esters, polyglycerolated fatty alcohols, glucamine derivatives, carboxylates, amino acid derivatives, alkyl sulfates, alkyl ether sulfates, sulfonates, isethionates, taurates, sulfosuccinates, alkyl sulfoacetates, phosphates and alkyl phosphates, polypeptides, anionic alkyl polyglucoside derivatives, fatty acid soaps, betaines, N-alkylamidobetaines and derivatives thereof, glycine derivatives, sultaines, alkyl polyaminocarboxylates and alkylamphoacetates, and mixtures thereof.

Claim 16: (Original): The composition according to Claim 1, which further comprises at least one solvent selected from the group consisting of alcohols comprising from 1 to 6 carbon atoms, polyols and mixtures thereof.

Claim 17: (Original): A method of treating the skin, the eyes, the scalp and/or the hair, comprising:

applying the composition of Claim 1 to the skin, the eyes, the scalp and/or the hair

thereby cleansing and/or removing make-up from the skin, the eyes, the scalp and/or the hair.

Claim 18: (Original): A method of treating greasy skin, comprising:

applying the composition of Claim 1 to the skin, thereby removing grease from the skin.

Claim 19: (Original): A method of disinfecting the skin and/or the scalp, comprising:

applying the composition of Claim 1 to the skin and/or the scalp, thereby disinfecting the skin and/or the scalp.

Claim 20: (Original): A method of cleansing the skin, the eyes, the scalp and/or the hair, comprising:

applying the composition of Claim 1 to the skin, the eyes, the scalp and/or the hair in the presence of water thereby forming a lather; and

removing the lather containing soiling residues by rinsing the lather from the skin, the eyes, the scalp and/or the hair with water.

Claim 21: (Original): A cosmetic mask, comprising:

an applied composition of Claim 1 as a mask on the skin of the face.

Claim 23. (Previously Presented): The composition according to Claim 1, wherein the thickening agent present in a composition thickening effective amoun is selected from the group consisting of

(a) polyethylene and/or polypropylene glycol esters having the formula:

$$RCOO\text{-}(EO)_m\text{-}(PO)_n\text{-}R'$$

wherein $0 < m \leq 300$ and $0 \leq n \leq 300$ and $m + n \geq 6$, R and R' represent,

independently of each other, hydrogen or a saturated or unsaturated, linear or

branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the proviso that R and R' are not simultaneously hydrogen;

(b) polyethylene glycol ethers having the formula

$$R\text{-}(EO)_m \text{---} (PO)_n\text{-}R'$$

wherein $0 < m \leq 300$ and $0 \leq n \leq 300$ and $m + n \geq 6$, R and R' represent, independently of each other, hydrogen or a saturated or unsaturated, linear or branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the provisos that (i) R and R' are not simultaneously hydrogen, and (ii) where either R or R' is hydrogen, the other comprises an alkyl chain comprising 12 to 22 carbon atoms, an aryl group, or mixtures thereof;

(c) alkoxylated polyol fatty acid esters;

(d) alkoxylated polyol fatty alcohol ethers;

(e) alkoxylated glyceryl triesters of fatty acids;

(f) ethoxyethylenated urethane derivatives modified with alkyl chains; and

(g) mixtures thereof.

APPENDIX II (EVIDENCE)

1. CTFA cosmetics handbook (Vol. 2, pp. 969-976) (2000).

APPENDIX III
(RELATED PROCEEDINGS APPENDIX)

None.